



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Serial No. .... 10/823,886  
Filing Date ..... April 13, 2004  
Confirmation No. .... 5660  
Inventor ..... Brad L. Sherwood  
Assignee ..... U.I.G., Inc.  
Group Art Unit ..... 3711  
Examiner ..... Stephen Luther Blau  
Attorney's Docket No. .... UI1-013  
Customer No. .... 021567  
Title ..... Correlated Set of Individually Numbered Golf Club Irons

**REPLY BRIEF**

**RESPONSE TO EXAMINER'S ANSWER DATED JULY 1, 2005**

To: Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**VIA U.S. EXPRESS MAIL**

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Responsive to the Examiner's Answer dated July 1, 2005, Appellant  
remarks as follows:

**REMARKS**

Under the "Grouping of Claims" section in the Examiner's Answer, it is  
asserted that the rejection of claims 1 and 69 stand or fall together because  
Appellant's Brief does not include a statement that this grouping of claims

does not stand or fall together and reasons in support thereof, citing 37 C.F.R. §1.192(c)(7). Appellant disagrees. The C.F.R. section to which the Examiner refers was not effective (having been "removed and reserved" effective Sept. 13, 2004) at the time of filing of Appellant's Appeal Brief. Accordingly, there was no section of the C.F.R. to which the Examiner refers with which Appellant needed to comply at the time of filing of its Appeal Brief.

Regardless, claims 1 and 69 do not stand or fall together. Claim 69 includes additional limitations that add patentable distinction relative to the limitations of the claim from which it depends, and the prior art which has been cited. Such reasons have been so argued, and accordingly, it is conceivable that the Board could rule that claim 69 is allowable while claim 1 is not allowable. However for the reasons argued in Appellant's Appeal Brief, both claims are seen to be allowable over the art of record.

In paragraph 10 under the "Response to Argument" portion of the Examiner's Answer, it is asserted that "Kobayashi teaches both spin profiles within a set (Fig. 3) and being able to use a method of modifying the coefficient of friction of a face to do such as being applicable for both opposite spin profiles (Col. 5, Lns. 37-47)." Kobayashi in no way in the cited section refers to its method as being applicable for both opposite spin profiles. Clearly, the language upon which the Examiner relies has to be taken in the context of everything else stated in the Kobayashi reference, which is clearly directed to providing decreasing coefficient of friction in

going from a lower numbered club to a higher numbered club in a set. The Examiner takes a statement in Kobayashi out of context with respect to the clear teaching of the document. Such only teaches spin modification by providing decreasing coefficient of friction in going from a lower numbered club to a higher numbered club in a set, not the reverse.

In paragraph 13 under the "Response to Argument" portion of the Examiner's Answer, it is asserted that "Kobayashi completely supports taking a method of modifying a coefficient of friction on a face between clubs in a set to produce a spin profile as desired." However, the desired profile is always disclosed by Kawamatsu as producing increasing golf ball spin in going from a low numbered club to a high numbered club in a set of golf clubs, the opposite of what Appellant claims. Further and accordingly, combining the references defeats the purpose of both references as one reference teaches increasing golf ball spin while the other teaches decreasing golf ball spin in going from a low numbered club to a high numbered club in a set of golf clubs.

In paragraph 12, the Examiner relies on coefficient of friction as apparently the only means by which spin is produced. The Examiner is mistaken. While it is recognized that coefficient of friction can impact degree of spin, such is not the only means to do so. As provided in Applicant's application, groove configuration is another manner by which by which spin can be impacted, and regardless of coefficient of friction. Coefficient of friction doesn't necessarily change because of groove

configuration, and coefficient of friction might increase, stay the same, or decrease among various clubs in Applicant's claim 1 set. Such is not recited in claim 1, as Applicant doesn't "regard" anything about coefficient of friction as its invention pursuant to 35 USC 112. Groove configuration can impact imparted spin independent of coefficient of friction, for example relative to bite into a golf ball for example as a knife edge could cut into a golf ball independent of coefficient of friction between the knife and ball.

In paragraph 8, the Examiner asserts Kobayashi and Kawamatsu are properly combinable as both deal with face configuration relative to impacting ball spin. However, Applicant's specification at p.2, ln.19 - p.3, ln.10 clearly evidences an objective of Applicant's invention in fabricating golf clubs which fall within the scope of USGA rules. And, Appendix II, paragraph 5b, of such rules provides:

**b. Impact Area Roughness and Material**

Except for markings specified in the following paragraphs, the surface roughness within the area where impact is intended (the "impact area") must not exceed that of decorative sandblasting, or of fine milling (see Fig. IX).

The Fig. 1 clubs of Kobayashi are clearly in violation of the above USGA rule, as such purposefully depict exceeding decorative sandblasting and exceeding fine milling. A person of skill in the art seeking to manufacture golf clubs in accordance with the USGA rules would not look to

teachings from a reference which clearly emphasizes constructions which are in violation of the USGA rules. Accordingly even with the Examiner's mistaken reliance on coefficient of friction issues, a person of skill in the art would not look to a reference which teaches illegal golf clubs, and therefore would not combine the two teachings. A person of skill would not look to the illegal teachings of Kobayahi regarding rough surfaces in trying to fabricate a USGA legal set of golf clubs. Further, altering the surface by increasing roughness would tend to tear up the golf balls, thereby defeating a purpose of the clubs.

With respect to paragraph 7, the Examiner's saying two grooves are one groove defies logic and reason. "Groove" should be interpreted as a person of skill in the art would interpret such word. The USGA rules are again helpful in this regard. For example, Appendix II, paragraph 5c(i) of the USGA rules provides:

The distance between edges of adjacent grooves  
must not be less than three times the width of a groove

Reading two grooves as one would likely always result in a violation of this rule, and thereby the Examiner's interpretation is not in accordance with how a person of skill in the art would interpret "groove".

Appellant asserts that its claims 1 and 69 are patentable over the art of record. With respect to what Appellant claims (namely, the stated decreasing golf ball spin relationship), the references teach the opposite

with respect to each other, and modification of the teaching of either reference renders the respective prior art unsatisfactory for its intended purpose regarding the change of golf ball spin within a golf club set. The Examiner has not considered both references in their entirety, including the disclosures therein which teach away from Appellant's claims, as is required by MPEP §2141.02. Further, the modification of the prior art which the Examiner suggests renders each prior art reference unsatisfactory for its intended purpose, and accordingly the suggested modification is not appropriate pursuant to MPEP §2143. Pursuant to the mandates of the MPEP, examination requires consideration of the whole reference, not only the portions in support of the Examiner's position. To allow otherwise enables an Examiner to merely pick and choose from portions of prior art references that support their position, and ignore those that do not support their position.

While MPEP §2144 indicates that the rationale/reason to modify a particular reference, or the rationale/reason to combine references, need not be the same as an Applicant's rationale/reason of the invention, §2144 does not enable an Examiner to ignore or get around the requirements of MPEP §2143 that the proposed modification cannot render an applied reference unsatisfactory/inoperable for its intended purpose when considered in the context of an Applicant's claim. The various sections of the MPEP mandates must be considered in harmony with one another, not separately and independently.

Reversal of the final rejections of claim 1 and 60 is respectfully requested.

Respectfully submitted,

FOR APPELLANT

Dated: 8-31-05

By: 

Mark S. Matkin  
Reg. No. 32,268

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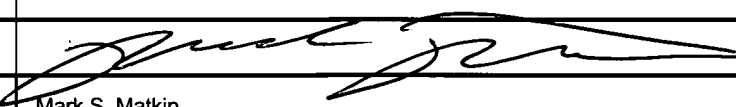
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